notify the seller associated with the accepted quote of the acceptance to facilitate purchase of the product.

70.   A computing system according to claim 56, further comprising instructions to indicate on the RFQ that the set of attributes was received from a customer through an authenticated buyer.

71.   A computing system according to claim 56, further comprising instructions to track a status of the transmitted RFQ's, and to selectively provide a customer with an update of the status of their request.

REMARKS

This response is presented to the Office Action mailed March 8th, 2002. In an effort to conclude prosecution of this matter, Applicant has amended claims 1 and 56, and has cancelled claim 51 without prejudice. Accordingly, claims 1, 30-50 and 52-71 remain pending. Without adopting the characterization of the references relied upon to reject such claim, Applicant respectfully submits that such amendments place the claims in condition for allowance and earnestly awaits notice thereof. Accordingly, Applicant respectfully requests reconsideration of the pending claims in light of the foregoing amendments and the subsequent remarks.

Claim Objections

In **paragraph 4** of the Action, claim 51 was objected to as being grammatically unsound. In particular, the Action identifies a potential verb inconsistency within the claim. In response, Applicant respectfully submits that the claim, as presented, is grammatically

correct. Nonetheless, in an effort to conclude prosecution of this matter, Applicant has cancelled the claim without prejudice, thereby rendering the objection to such claim moot.

In **paragraph 5** of the Action, claim 51 was further objected to as being a substantial duplicate of claim 48. Without adopting this characterization of claim 51, claim 51 has been cancelled without prejudice, thereby rendering the objection to such claim moot.

35 USC §112, second paragraph, Claim Rejections of Claim 48

In **paragraphs 8** of the Action, claim 48 is rejected under 35 USC §112, second paragraph, as failing to set forth the subject matter which Applicant(s) regard as their invention. In response, Applicant respectfully disagrees.

In particular, the Action rejects claim 48 on the basis of language that no longer appears in the claim. As presented above, Applicant's understanding is that the term "authenticated buyer" has been replaced with "intermediary", per the suggestion of the Examiner. If this understanding is in error, please advise. Otherwise, Applicant respectfully requests that the 112, second paragraph, rejection of claim 48 be withdrawn.

35 USC §103(a) Claim Rejections of Claims 1, 55 and 56 – Inherency

In **paragraph 9** of the Action, claims 1, 55 and 56 were rejected as being unpatentable over the previously cited TechShopper article. In response, Applicant maintains the arguments presented in previous responses and adds the following in respectfully traversing the rejection of such claims.

Claim 1

As introduced in previous responses, claim 1, is generally directed to a method comprising:

> receiving a set of product attributes denoting a customer's desired product configuration;
> automatically transmitting an automatically prepared request for quote (RFQ) to an automatically selected set of sellers, the RFQ including the customer's desired configuration; and
> notifying the requesting customer upon receipt of quote(s) in response to the transmitted RFQ

The Action states that Applicant has failed to demonstrate how the elements of receiving, transmitting and notifying are not inherent in the TechShopper reference. Applicant respectfully submits that Applicant has provided in prior responses examples of how the TechShopper reference may work that differs from the proposal put for the in the Action rejecting such claims. In this regard, Applicant has demonstrated that, while the TechShopper reference *may* work as suggested in the Action, it does not *necessarily do so* and that such necessity *would be obvious to a skilled artisan*, as is required by patent law as a foundation for a rejection based on inherent teachings.

In particular, Applicant respectfully submits that it is not inherent that TechShopper transmit an RFQ to an automatically selected set of sellers. Indeed, Applicant has provided support within the TechShopper reference itself which clearly states that the Custom Quote and Request feature of TechShopper relied upon by the Examiner includes a broadcast feature to "instantly broadcast[s] the buyer's custom quote request to *their* selected sellers". That is, TechShopper merely discloses a system that enables *a user* to select one or more

sellers from which to solicit a quote. In this regard, TechShopper not only fails to inherently disclose the claim element, but explicitly teaches away from it.

While the Action asserts that the SellerFinder feature "certainly does some automatic selection of sellers", pointing to the disclosure that the feature "*filters* sellers by service and support, which, obviously suggests to one skilled in the art geographical considerations". Applicant respectfully disagrees.

The sentence in TechShopper reference upon which the Action relies discusses sorting such vendors based on service *policies* and support *policies*. Service policies and support policies are generally developed by the manufacturer and denote whether parts and/or labor is covered in the repair of a given product over a given period of time. Such policies are generally not restricted to geographic considerations, and there is no disclosure or suggestion that the SellerFinder feature extends beyond such policies to sort the list of vendors based on geographical considerations.

Thus, while the TechShopper reference *may*, in fact, work as suggested in the Action *it does not necessarily do so, nor would such necessity be readily apparent to one skilled in the art*. In this regard, the TechShopper reference fails to meet the standard for inherency introduced in past responses. Accordingly, Applicant respectfully submits that one or more elements of the receiving, transmitting and notifying elements of, e.g., rejected claim 1 are neither inherent nor suggested by the TechShopper reference. Consequently, Applicant respectfully requests that the §103(a) rejection of claim 1 be withdrawn.

Claims 55 and 56

Applicant respectfully submits that claims 55 and 56 include claim elements similar to those discussed above in amended claim 1 and are, therefore, likewise patentable over the TechShopper reference employing arguments analogous to those presented above. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

§103(a) Rejection of Claims 1, 55 and 56 – TechShopper in view of Luke

In **paragraph 10** of the Action, the Examiner provides a second basis for a §103(a) rejection of claims 1, 55 and 56. In particular, the Action rejects claims 1, 55 and 56 as being unpatentable over the TechShopper reference in view of a patent issued to Luke et al. (USP 6,131,087). More particular, the Action points to Luke as curing the argued deficiency in TechShopper of failing to automatically select seller(s) to receive an RFQ. In response, Applicant respectfully traverses the rejection of such claims.

The Luke Reference

The Luke reference is generally drawn to a method for automating electronic market exchange transactions. In this regard, Luke discloses a system wherein an offeror identifies an exchange partner (block 220), an account registry verifies accounts of exchange participants (510), the offeror responds to solicitation, submits an offer of points (520), whereupon the exchange partner has three distinct courses of action, accept, counter offer, or rejection (530-600) (see, Fig. 3; col. 9, line 49 through col. 10, line 14). In this regard, while the account registry of Luke may verify accounts of exchange participants, the registry does not

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automatically select the exchange partners to which an offer is to be submitted. Indeed, Luke

explicitly states that Fig. 3 illustrates the negotiation process employed by two parties, an

originator of offer data and an originator of solicitation data ... once the originator has

identified solicitation data that fits his needs **and identified an exchange partner** (col. 9, lines

49-53).

In contradistinction to the Luke reference, amended claim 1 includes the feature of:

> automatically transmitting an automatically prepared
> request for quote (RFQ) to *an automatically selected set of*
> *sellers*, the RFQ including the customer's desired
> configuration;

That is, the claimed invention requires transmitting of an RFQ to an automatically selected set

of sellers. In this regard, the selection of the set of seller(s) to receive the RFQ does not require

the intervention of the buyer or, in the lexicon of Luke, the originator.

Luke, as provided above, explicitly states that the originator identifies and selects an

exchange partner (col. 9, lines 49-53) with which to complete a market transaction. In this

regard, Luke merely discloses a manual process of selecting an exchange partner (or, seller),

while the claimed invention provides that such selection is automatic. Applicant respectfully

submits that an artisan reading the Luke reference, and its manual selection of exchange

partners, would not be motivated *by the reference* to develop a system which automatically

selects an exchange partner. There is no foundation within the Luke reference itself that

provides for an extension of the explicit teachings of Luke.

Accordingly, Applicant respectfully submits that the Luke reference fails to cure the

deficiency of the TechShopper reference, and that the combination actually teaches away from

that which is claimed in, e.g., rejected claim 1. Thus, Applicant respectfully submits that claim

1 is patentable over the TechShopper reference in view of the Luke reference, and requests that the §103(a) rejection of claim 1 be withdrawn.

Claims 55 and 56

Applicant respectfully submits that claims 55 and 56 include claim elements similar to those discussed above in amended claim 1 and are, therefore, likewise patentable over the TechShopper reference in view of the Luke reference employing arguments analogous to those presented above. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

§103(a) Rejection of claims 32-42, 45, 54 and 59-67

In **paragraph 11** of the Action, claims 32-42, 45, 54, and 59-67 were rejected as being unpatentable over the TechShopper article or, alternatively over the TechShopper article in view of Luke, as applied to claim 1, as discussed above, in further view of well-known business practices. In response, Applicant traverses the rejection of such claims.

Applicant notes at the onset that, at certain points through the paragraph 11 rejection of the foregoing claims, the Examiner cites a patent issued to Dworkin and a patent issued to Green, without introducing such references as a basis for rejection in the introductory paragraph (see, e.g., page 8, mid-page; page 13, top of page). Clarification as to the basis of the rejection of such claims is requested to provide the statutory opportunity for response.

Applicant maintains the arguments of past responses traversing the Official Notice of well-known business practices relied upon in the rejection. Moreover, adopting the characterization of the well-known business practices, and without the need to further

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characterize the well-known business practices, Applicant respectfully submits that the practices are not cited as curing and do not, in fact, cure the deficiencies of the TechShopper or Luke references with respect to claims 1 or 56. Accordingly, Applicant respectfully submits that claims 1 and 56 remain patentable over the cited combination(s) of the TechShopper, Luke and/or business practices.

Accordingly, in addition to any independent basis for patentability, claims 32-42, 45, 54, and 59-67 are dependent on patentable base claims 1 or 56 and are, in this regard, patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

35 USC §103(a) Rejection of Claims 43, 44 and 68

In **paragraph 12** of the Action, claims 43, 44 and 68 were rejected as being unpatentable over the TechShopper reference, or alternatively under the TechShopper reference in view of Luke as applied to claim 1, and further in view of Luke. In response, Applicant respectfully traverses the rejection of such claims.

Applicant respectfully submits that, in addition to any independent basis for patentabiliy, claims 43, 44 and 68 depend from patentable base claim 1 or 56 and, as such, as similarly patentable over the cited references by virtue of at least the arguments introduced above. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

35 USC §103(a) Rejection of Claims 52-53 and 71

In **paragraph 13** of the Action, claims 52-53 and 71 were rejected as being unpatentable over the TechShopper reference in view of well-known business practices in further view of a patent issued to Walker (USP 5,794,207) under §103(a). In response, Applicant respectfully traverses the rejection of such claims.

In accordance with Applicant's past characterization of the Walker reference, Applicant respectfully submits that the Walker reference is not cited as curing and does not, in fact, cure the limitations of the TechShopper and "well-known" business practices presented above. In this regard, Applicant respectfully asserts that claims 1, 55 and 56 remain patentable over the cited TechShopper, conventional business practices, and Walker references.

Applicant notes that, in addition to any independent basis for patentability of claims 52, 53 and 71, such claims are dependent on otherwise patentable base claims 1 or 56 and are likewise patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

35 USC §103(a) Rejection of Claims 30, 31, 46-49, 50, 51, 57, 58, 69 and 70

In **paragraph 14** of the Action, claims 30, 31, 46-49, 57, 58, 69 and 70 were rejected as being unpatentable over the TechShopper reference in view of well-known business practices in further view of a patent issued to Dworkin (USP 4,992,940) under §103(a). In response, Applicant respectfully traverses the rejection of such claims.

In accordance with Applicant's past characterization of the Dworkin reference, Applicant respectfully submits that the Dworkin reference is not cited as curing and does not, in fact, cure the limitations of the TechShopper and "well-known" business practices presented above. In this regard, Applicant respectfully asserts that claims 1, 55 and 56 remain patentable over the cited TechShopper, conventional business practices, and Dworking references.

Applicant notes that, in addition to any independent basis for patentability of claims 30, 31, 46-49, 57, 58, 69 and 70, such claims are dependent on otherwise patentable base claims 1 or 56 and are, likewise, patentable over the cited references by virtue of at least such dependency. Accordingly, Applicant respectfully requests that the §103(a) rejection of such claims be withdrawn.

Amendment of claim 1 and 56

Despite the arguments above distinguishing claim 1 and claim 56 over the cited references, in an effort to conclude prosecution of the pending application, Applicant has amended claims 1 and 56, as presented above. Applicant respectfully submits that such amendments further distinguish claims 1 and 56 over the cited references, as none of the cited references disclose or suggest automatically transmitting an automatically prepared RFQ to

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an automatically selected set of sellers as provided, albeit in accordance with their respective embodiments, in amended claims 1 and 56. Applicant respectfully submits that such amendments provide a further basis of patentability.

Conclusion

In light of the foregoing amendments and remarks, Applicant respectfully asserts that claims 1, 30-50, and 52-71 are in condition for allowance, and earnestly awaits notice thereof. Absent a notice of allowance, Applicant respectfully requests that the finality of the Action be withdrawn. **In an effort to expedite prosecution of this matter, the Examiner is invited to call the undersigned counsel for the Applicant to discuss any further issues preventing allowance of the currently pending claims.**

Please charge any shortages and credit any overages to our Deposit Account No. 02-2666.

Dated: July 8, 2002

Respectfully submitted,
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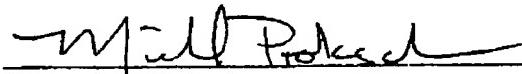
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Appendix A:

Version of the Claims with Markings

In the Claims:

Please amend the claims as follows:

1. (Amended) A <u>computer-implemented</u> method comprising:

receiving a set of product attributes denoting a customer's desired product configuration;

<u>automatically</u> transmitting <u>an automatically prepared</u> request for quote (RFQ) to an automatically selected set of sellers, the RFQ including [the customer's desired configuration] <u>at least a subset of the received set of product attributes</u>; and

notifying the requesting customer upon receipt of quotes in response to the transmitted RFQ.

56. (Amended)   A computing system comprising:

a memory system having stored therein a plurality of executable instructions; and

a processor system, coupled to the memory system, to access and execute at least a subset of the plurality of executable instructions to <u>enable the computing system to</u> receive a desired set of product attributes from a requesting customer, to <u>automatically</u> transmit a request for quote (RFQ) dynamically generated from the received set of product attributes to an automatically selected set of sellers, and to notify the requesting customer of the receipt of one or more quotes in response to the transmitted RFQ's.